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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,654	10/25/2001	Jens Erik Sorensen	52-162	7276

22653 7590 11/24/2004

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EXAMINER

PARDO, THUY N

ART UNIT PAPER NUMBER

2165

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/980,654

Applicant(s)

SORENSEN ET AL.

Examiner

Thuy Pardo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,32,35,39-48,67,69 and 77-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,32,35,39-48,67,69 and 77-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>29 July 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's Amendment filed on September 16, 2004 in response to Examiner's Office Action has been reviewed.

2. Claims 2, 3, 32, 35, 39-48, 67, 69, and 77-79 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 3, 32, 35, 39-48, 67, 69, and 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchio et al. (Hereinafter "Uchio") US Patent Application No. US 2002/0019836 in view of Kossovsky et al. (Hereinafter "Kossovsky" US Patent Application No. US 2002/0002523.

As to claim 2, Uchio teaches a method of managing ideas [see the abstract], comprising: maintaining a computer database for accumulating ideas for prospectively patentable inventions, wherein said ideas include needs and requirements of said inventions [0216-0220 of page 11] and systematically establishing contractual obligation by contributors of said ideas to

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the database to transfer property rights to inventions derived at least in part from said accumulated ideas [0069 of page 3; 0059 of pages 2-3].

However, Uchio does not explicitly teach wherein said transfer is for contingent economic gain. Kossovsky teaches online commercial network system designed to facilitate purchase and license exchange of IP assets [see the abstract, 0009 of page 1].

Therefore, it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to add the features of Kossovsky to the system of Uchio as an essential means to increase the efficiency and reliability of the system in determining an accurate market value for the patented technology.

As to claim 69, all limitations of this claim have been addressed in the analysis above, and this claim is rejected on that basis.

As to claim 3, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches using at least one computer [0060 of page 3].

As to claim 32, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches systematically entering into said database all ideas contributed for entry into said database [ab; 0061-0062 of page 3].

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As to claim 35, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches systematically entering into said database ideas contributed for entry into said database without requiring any contributor of said ideas to have subject matter expertise as a prerequisite for entry of said contributions [IP listed on the exchange in database, 0043 of page 2].

As to claim 39, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches requiring persons to enter into a membership as a prerequisite for viewing a portion of said database containing at least some of said accumulated ideas [0169 of page 9].

As to claim 40, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches requiring contributors of ideas for prospective entry into said database to enter into a membership as a prerequisite for contributing ideas for entry into said database [0147 of page 7].

As to claim 41, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches facilitating preparation and/or filing of patent applications for at least some inventions derived at least in part from said accumulated ideas [abstract].

As to claim 42, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches auctioning at least some right under the patent rights to at least some inventions derived at least in part from said accumulated ideas [ab; fig. 3-5].

As to claim 43, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches recording a time of receipt of each idea contributed for entry into said database [0089 of page 4].

As to claim 44, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches recording a time of publication in said database of each accumulated idea [fig. 30].

As to claim 45, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches recording a time of first public viewing from said database of each accumulated idea [fig. 12].

As to claim 46, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches providing contingent contractual rights to at least some inventions derived at least in part from said accumulated ideas [0112 of page 9].

As to claim 47, Uchio and Kossovsky the invention substantially as claimed. Kossovsky further teaches enabling ideas contributed to said database to be integrated within said database to thereby facilitate derivation of inventions from said integrated ideas [ab].

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As to claim 48, Uchio and Kossovsky teach the invention substantially as claimed. Kossovsky further teaches systematically establishing contractual obligations by contributors of said ideas to permit immediate public disclosure of said ideas contributed by said contributors [ab].

As to claim 67, Uchio and Kossovsky teach the invention substantially as claimed. Uchio further teaches that each step is performed systematically [fig. 2-4; 0016 of page 1].

As to claims 77-79, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

Response to Arguments

4. Applicant argues that the combination of Taylor, Crandall would be improper.

As to point this, Examiner respectfully disagrees. Examiner believes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Uchio provides an intellectual property management system for managing documents and various procedures related to a patent application [see ab and fig. 1] and the head office of an enterprise performing economic activities such as managing the intellectual property such as a patent [0057]. Kossovsky teaches online

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commercial network system designed to facilitate purchase and license exchange of intellectual property assets. Kossovsky enhances Uchio's system for valuing and IP asset and for management decisions. Furthermore, Examiner believes that the recitation of "said transfer is for contingent economic gain" is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the recitation for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant argues that Uchio does not teach establishing contractual obligations.

Examiner respectfully disagrees. Examiner believes that this feature has been taught by Uchio. Uchio teaches a plurality of external companies 111 for cooperatively perform research and development with the enterprise group 110 [see fig. 1]. They manage the products of the cooperative research and development based on the mutual contract and patent rights [0069 of page 3]. Examiner also believes that the contractual obligations are inherent established based on the mutual contract and patent rights among a plurality of external companies and the enterprise group. Uchio also teaches using a computer system for systematically managing this feature [obligations for a staff, fig. 25; obligations for the supervisor of staffs, fig. 26].

Applicant argues that Uchio does not teach systematically entering into said database all ideas contributed for entry into said database.

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Examiner respectfully disagrees. Uchio teaches inputting patent applications to the system's database [S1903 of fig. 19].

Applicant argues that the cited references do not teach the feature of without requiring any contributor of said ideas to have subject matter expertise as a prerequisite for entering ideas into said database.

Examiner respectfully disagrees. Although neither Uchio nor Kossovsky explicitly teach the feature of without requiring any contributor of said ideas to have subject matter expertise as a prerequisite for entering ideas into said database, the feature is inherent in the intellectual property management system. For example, patent applications (or idea applications) can be entered into the database system by the LIEs (Legal Instrument Examiners) or by the contractors who need not have subject matter expertise of said ideas.

Applicant argues that Uchio does not teach entering into a membership as a prerequisite for viewing or contributing invention ideas.

As to this point, Examiner respectfully disagrees. Examiner believes that this feature is taught by Uchio. Uchio teaches assigning serial number and registration number for every invention applications for viewing and contributing invention ideas [see fig. 30, 33]. Kossovsky also teaches this feature [see fig. 16A].

Applicant argues that Uchio does not teach facilitating preparation and/or filling of patent applications for at least some inventions derived at least in part from ideas accumulated in the

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database. Examiner respectfully disagrees. Uchio teaches that information related to a patent application is accumulated in a database and facilitating preparation and/or filling of patent applications for at least some inventions derived at least in part from ideas accumulated in the database [ab; S1505, S1508].

Applicant argues that Uchio does not teaches recording the time of receipt, publication, or viewing of each idea. Examiner respectfully disagrees. Examiner believes that this feature is taught by Uchio. Uchio teaches recording the time of receipt, publication, or viewing of each idea [fig. 30; 0089 of page 4].

Application argues that Kossovsky does not explicitly teach auctioning at least some right under patent rights to at least some inventions derived at least in part from said accumulated ideas. As to this point, Examiner respectfully disagrees. Kossovsky teaches auctioning at least some right under patent rights to at least some inventions derived at least in part from said accumulated ideas [see fig. 3-5] in order to transfer the IP rights to the highest bid buyer [0051-0053 of page 3].

Applicant argues Kossovsky does not teach permitting immediate public disclose of said ideas. As to this point, Examiner respectfully disagrees. Kossovsky teaches permitting immediate public disclose of said ideas by auctioning IP assets online [see ab; fig. 3-5; 0051-0054 of pages 3-4; 0060-0062 of page 5].

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5. Applicant's arguments filed on September 16, 2004 have been fully considered but they are not persuasive.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is 571-272-4082. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at 571-272-4083.

The fax phone number for the organization where this application or proceeding is assigned are as follows:

(703) 872-9306 (Official Communication)

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and/or:

(703) 746-5616 (*Use this Fax#, only after approval by Examiner, for "INFORMAL" or "Draft" communication. Examiner may request that a formal/amendment be faxed directly to then on occasions*).

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

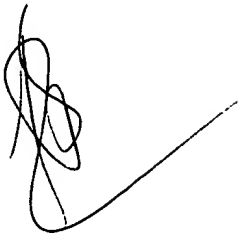
(703) 308-5359, (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

November 22, 2004



**THUY N. PARDO
PRIMARY EXAMINER**